

## **REMARKS**

This application has been reviewed in light of the Office Action mailed May 11, 2005.

Reconsideration of this application in view of the below remarks is respectfully requested.

Claims 3-5, 8-14, 17-22, 24-32 are pending in the application with Claims 21 and 27 being in independent form. By the present amendment, Claims 1-2, 6-7, 15-16 and 23 have been canceled, Claims 3-5, 8-12, 21, 24 have been amended, and Claims 27-32 have been newly added. No new subject matter has been introduced by way of the present amendment.

Initially, Applicant thanks the Examiner for indicating that Claims 5, 14 and 23-24 contain patentable subject matter and would be allowable if rewritten in independent form and including all the limitations of the base claim and any intervening claims. The limitations recited by Claim 23 have been added to amended Claim 21 and Claim 23 has been canceled.

### **I. Rejection of Claims 21, 22, 25 and 26 under 35 U.S.C. §102(b)**

Claims 21, 22, 25 and 26 have been rejected under 35 U.S.C. §102(b) for allegedly being anticipated by U.S. Patent No. 6,068,627 issued to Orszulak et al.

By the present amendment, Claim 21 has been amended to include the allowable limitation of Claim 23, such that amended Claim 21 recites: “...stopping reading of information by the first information exchange functioning unit after the drive state of the drive device is set; and generating the energy in the drive device based on the drive state after reading of information by the first information exchange functioning unit is stopped” (Emphasis added). Claims 22, 25 and 26 depend from independent Claim 21 and thus include the limitations recited by that independent claim. Therefore, for at least the reasons given above, Claims 21, 22, 25 and 26 are believed patentably distinct over the prior art. Accordingly, Applicant requests withdrawal, with respect to Claims 21, 22, 25 and 26, of the rejection under 35 U.S.C. §102(b) over Orszulak et al.

## II. Rejection of Claims 1-4 and 6-11 Under 35 U.S.C. §103(a)

Claims 1-4 and 6-11 have been rejected under 35 U.S.C. §103(a) for allegedly being unpatentably obvious over Orszulak et al. in view of U.S. Patent No. 4,038,625 issued to Tompkins et al. By the present amendment, Claims 1, 2, 6 and 7 have been canceled, thus rendering the rejection of these claims moot. The remaining claims, namely Claims 3-4 and 8-11 have been amended to depend from newly added independent Claim 27.

The present invention, as recited in Applicant's claims, includes a control unit that changes a setting for an output of a drive device based on information read out from an identification information storage unit. The information specifies the surgical instrument type connected to the surgical operation apparatus. The control unit changes the settings and enables the output by the drive device only after it confirms the completion of acquisition of the identification information. This function allows the control unit to prevent the drive device from supplying the energy to the surgical instrument before the settings change has been completed.

Though Orszulak et al. discloses the structure for exchanging identification information between the surgical instrument and the surgical operation apparatus, Orszulak et al. fails to disclose or suggest a control method or structure for enabling the energy output only after the confirmation of the completion of information acquisition and settings change. Thus, Orszulak et al. does not disclose or suggest the present invention, as recited in Applicant's Claim 27. Specifically, Claim 27 recites in part: "an identification information storage unit that stores identification information of the surgical instrument; an information exchange unit that reads out information stored in the identification information storage unit according to a connection between the first connector and the second connector; and a control unit that controls generation of the energy by the drive device, the control unit changing a setting for the generation by the

drive device, after the information exchange unit completes reading out the information, based on the read-out information, and validating the command from the switch on the generation of the energy by the drive device. ” (Emphasis added).

Additionally, Tompkins et al. fails to overcome the above-mentioned deficiencies in Orszulak and thus, neither Orszulak et al. nor Tompkins et al., taken alone or in any proper combination, disclose or suggest the present invention as recited by Applicant’s Claim 27. Accordingly, Applicant requests withdrawal of the rejection to Claims 3-4 and 8-11 under 35 U.S.C. §103(a) over Orszulak et al. in view Tompkins et al.

### **III. Rejection of Claims 12, 13 and 15-20 Under 35 U.S.C. §103(a)**

Claims 12, 13 and 15-20 have been rejected under 35 U.S.C. §103(a) for allegedly being unpatentably obvious over Orszulak et al. in view of Tompkins et al. and further in view of U.S. Patent Application No. 10/124,169 issued to Wallace et al. By the present amendment, Claims 15 and 16 have been canceled, thus rendering the rejection of these claims moot. Claims 12, 13, and 17-20 depend from independent Claim 27 and thus are limited by the limitations recited by that independent claim.

While Wallace et al. discloses a robotically controlled articulated arm for minimally invasive tele-surgical applications, Wallace et al. fails to overcome the deficiencies identified in Orszulak et al. and Tompkins et al., as discussed above. Therefore, Orszulak et al., Tompkins et al. and Wallace et al., taken alone or in any proper combination, fail to disclose or suggest the present invention as recited by Applicant’s independent Claim 27. Accordingly, Applicant requests withdrawal of the rejection to Claims 12, 13, and 17-20 under 35 U.S.C. §103(a) over Orszulak et al. in view Tompkins et al.

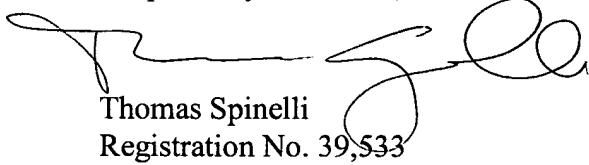
Additionally, newly added Claims 28-32 depend from independent Claim 27 and thus are limited by the limitations recited by that independent claim. Therefore, for at least the reasons given above for Claim 27, Claims 28-32 are believed patentably distinct over the prior art.

### CONCLUSIONS

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely, Claims 3-5, 8-14, 17-22, 24-32 are believed to be in condition for allowance and patentably distinguishable over the art of record.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call Applicant's undersigned attorney at the number indicated below.

Respectfully submitted,



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